

REMARKS

Changes made to the Application are made to improve the clarity, readability, and understanding of the Application or the portion of the Application changed. No adds new matter. No amendment narrows the scope of the claims. The amendments to the specification are made merely as cosmetic amendments to improve the readability and coherence of the resulting patent.

Status of Prosecution

Appellant filed the original application on June 20, 2003.

The Examiner entered a telephonic restriction, with traverse, and limited examination of the Application to claims 1-22. Claims 23-31 were withdrawn. The Examiner thereafter mailed a first, non-final office action on February 23, 2004 ("First Office Action"). Appellant filed a Reply on March 19, 2004 ("First Reply of Applicant"). In response, the Examiner entered a Final Office Action on May 6, 2004 ("Final Office Action"). Appellant filed a Reply to the Final Office Action, and a Notice of Appeal to the Board, on June 2, 2004. The Examiner's Primary Examiner entered an Advisory Action dated June 30, 2004, stating that the Listing of Claims in the Reply to the Final Office Action did not comply with 37 CFR §1.121(c). Applicant filed an Amended Appeal Brief on January 10, 2005.

Following review of Applicant's Amended Appeal Brief by an Appeal Conference panel, the file was returned to the Examiner with instructions. The Examiner thereafter entered a new non-final office action on March 22, 2005 that reopened prosecution and advanced new arguments for rejection of claims 1-22 ("Reopened Office Action"). This Reply to Office Action is in response to the Reopened Office Action.

Applicant requests reconsideration and withdrawal of the rejections of claims 1-22.

General Objections and Rejections

A. Drawing Figure and Related Matters. On page 2 of the Reopened Office Action the Examiner objected to the drawing figures, stating, "reference characters '36' and '40' have both been used to designate 'ball washer assemblies.'" In a related matter, on page 3 of the Reopened Office Action the Examiner rejected claim 11 under 35 U.S.C. §112, first paragraph. Applicant believes that both the objection to the drawing figures, and the rejection under 35 U.S.C. §112, are related and are overcome by Applicant's amendment to the specification as

explained below. Accordingly, Applicant respectfully urges that the drawing figure objection and claim rejections of the Examiner be withdrawn.

B. Anticipation Rejections under 35 U.S.C. §102(b): On page 4 of the Reopened Office Action the Examiner continues the rejection of claims 1-3 from earlier office actions as anticipated by U.S. Patent No. 5,697,320 issued to Murray on December 16, 1997 (“Murray Patent”), an argument that Applicant respectfully traverses. Accordingly, Applicant respectfully urges withdrawal of the rejections under 35 U.S.C. §102(b).

C. Obviousness Rejections under 35 U.S.C. §103(a): On pages 5-10 of the Reopened Office Action the Examiner continues the rejections of claims 4-22 from earlier office actions for obviousness over a variety of combinations and permutations of references.

Thus, on page 5 of the Reopened Office Action the Examiner continues from earlier office actions the rejection of claim 4 as obvious over the Murray Patent in view of U.S. Patent No. 5,704,749 issued January 6, 1998 to Landgrebe (“Landgrebe Patent”), an argument that Applicant respectfully traverses.

On page 6 of the Reopened Office Action the Examiner continues from earlier office actions the rejection of claim 5 as obvious over the Murray Patent in view of the Landgrebe Patent, in further view of U.S. Patent No. 1,257,536 issued to Schroeder on February 26, 1918 (“Schroeder Patent”), an argument that Applicant respectfully traverses.

On pages 7-9 of the Reopened Office Action the Examiner continues from earlier office actions the rejection of claims 6-13 and 16-22 as obvious over the Murray Patent in view of the Schroeder Patent, an argument that Applicant respectfully traverses.

On pages 9-10 of the Reopened Office Action the Examiner continues from earlier office actions the rejection of claims 14 and 15 as obvious over the Murray Patent in view of the Schroeder Patent, and in further view of the Landgrebe Patent, an argument that Applicant respectfully traverses.

Accordingly, Applicant respectfully urges withdrawal of the rejections under 35 U.S.C. §103(a).

Drawing Figure Objections and Rejection under 35 U.S.C. §112/1

A. Reference Characters: On page 2 of the Reopened Office Action the Examiner objected to the drawing figures, stating that “reference characters ‘36’ and ‘40’ have both been used to designate ‘ball washer assemblies.’”

Applicant has determined, however, that the amendments to the specification shown above not only improve the clarity, readability, or understanding of the application, but also obviate the basis of the objection. Applicant acknowledges having omitted a necessary qualifying phrase, namely the phrase “as formed in,” from the now amended portion of the specification.

Support for the specification amendment is found in the Application at page 6, lines 26-27, which provides: “In addition, as perhaps best shown in Figure 2, base 12 also includes one or more bores 24. As shown also in Figure 2, “one or more bores 24a-c are formed in base 12.” Further, claim 11 is directed to “means formed in the base for mounting the base on a curved surface.” The ball washer assemblies 40 are not “formed in the base.” Accordingly, the lead line of reference character 36 in Figure 3 of the Application correctly points toward the one or more bores 24.

B. The §112 Rejection: The Applicant respectfully submits that the rejection under §112/1 also has been overcome by the amendments to the specification. If the Examiner believes otherwise, Applicant urges a telephone call from the Examiner to discuss the matter.

Rejection Under 35 U.S.C. §102(b)

On page 4 of the Reopened Office Action the Examiner continues from earlier office actions the rejections of claims 1-3 as anticipated by U.S. Patent No. 5,697,320 issued to Murray on December 16, 1997 (“Murray Patent”), an argument that Applicant respectfully traverses.

35 U.S.C. §102 (b) provides:

“A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States....”

Applicant respectfully submits that the present invention was neither patented nor described in a printed publication in this or a foreign country, nor was it in public use nor on sale

in this country, more than one year prior to the date of filing of the present application in the United States. Claims 1-3 are patentable because the Murray Patent does not anticipate them.

The Murray Patent does not satisfy the “all-elements” rule of MPEP §2131, which provides:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference...The identical invention must be shown in as complete detail as contained in the claim...[and] the elements must be arranged as required in the claim. (Emphasis added)

Specifically, the Murray Patent does not anticipate claims 1-3 of the Application for at least these reasons:

A. The Murray Apparatus is not Variably Positionable. On page 4 of the Reopened Office Action the Examiner asserts that the Murray Patent discloses a “variably positionable” coupler because Applicant’s independent claim 1 is directed to a variably positionable coupler.

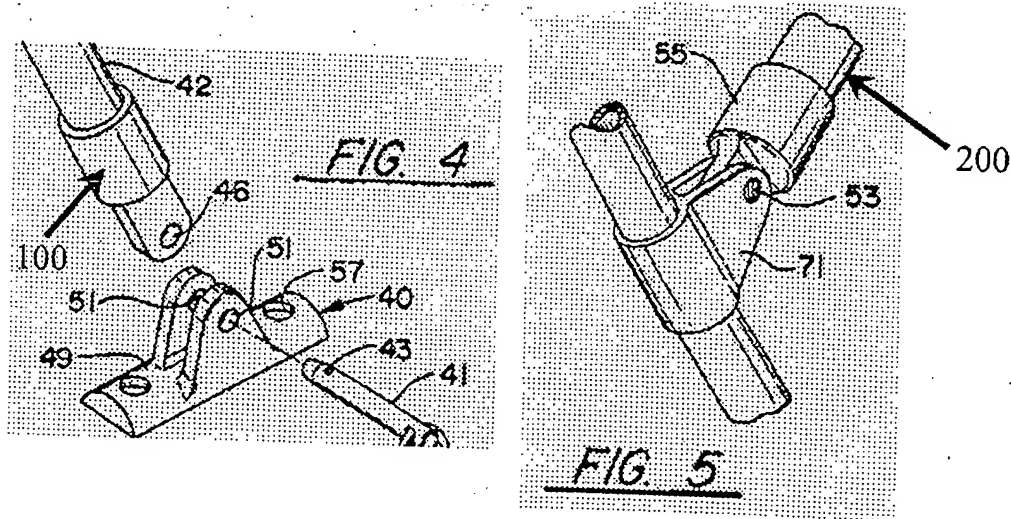
The apparatus of the Murray Patent is not “variably positionable” as that term is defined in the Application’s specification at page 2, lines 8-26:

[A] previously unaddressed need exists in the industry for a new and useful apparatus, and method for manufacturing such an apparatus, capable of being mounted on a curved mounting surface that also is capable of being adjusted to accommodate any dimension and configuration of boat hull or other structure to which the apparatus is attached. Particularly, there is a significant need for a variably positionable coupler system mountable on a curved surface that overcomes the effects of forces that may be applied to a shaft mounted on such a coupler system...[I]n the boat industry, no effort has been made to offer a standardized variably positionable coupler that is universally adjustable for accommodation to any dimension of the boat, any dimension of shafts, and to any shape of the hull of a craft, including a curved surface. (Emphases added.)

The apparatus of the Murray Patent is not universally adjustable. As is evident from the marked-up figures shown by the Examiner on page 4 of the Reopened Office Action, and reproduced on page 14 of this Reply, the component that the Examiner labeled “tub 100” allows leg 42 to be positionable in one plane only. Together, components 42 and 100 may rotate only in

one plane around the axis formed when quick release pin 41 is inserted through apertures 52 (see reproduced Figures 4-5 of the Murray Patent, and column 3, lines 58-64).

FIGURES 4-5 OF MURRAY PATENT



Applicant's coupler, however, is not limited to restricted rotation in a single plane. Rather, Applicant's coupler is variably positionable and universally adjustable for mounting on any shape of hull of a craft, including a curved surface. This unique feature of Applicant's coupler is emphasized and demonstrated graphically by Applicant's drawing Figures 5-8B, reproduced on page 15 of this document.

In the "Brief Description of the Drawing" beginning on page 5 of the Application, amplification of what the Figures show and demonstrate is provided (emphasis added):

Figure 5 is a perspective view of the coupler showing possible variable positions;

Figure 6 is a perspective view showing yet another of the variable positions of the coupler;

Figure 7 is a perspective view showing another variable position of the coupler;

Figure 8A is a perspective view showing another variable position of the coupler;

Figure 8B shows another variable position of the coupler on the ball washers...

FIGURES 5-8B OF APPLICATION

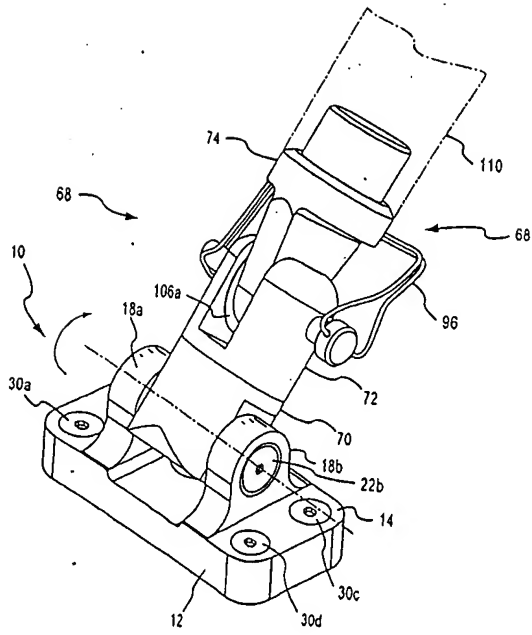


FIG. 5

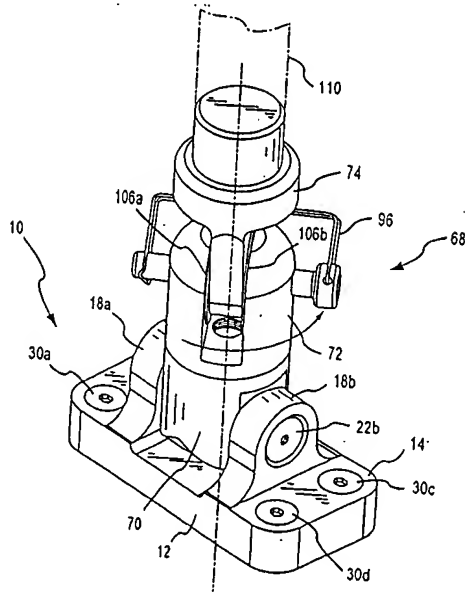


FIG. 6

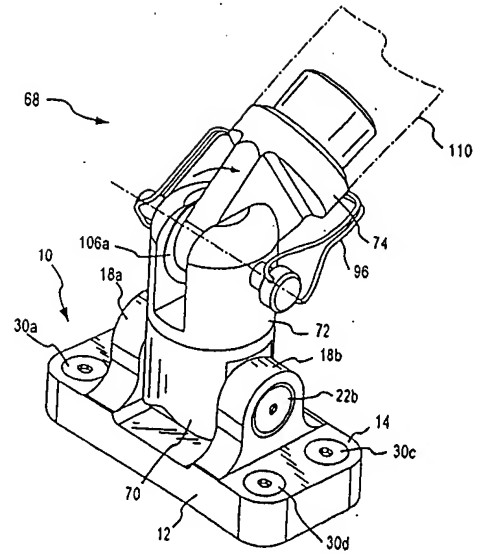


FIG. 7

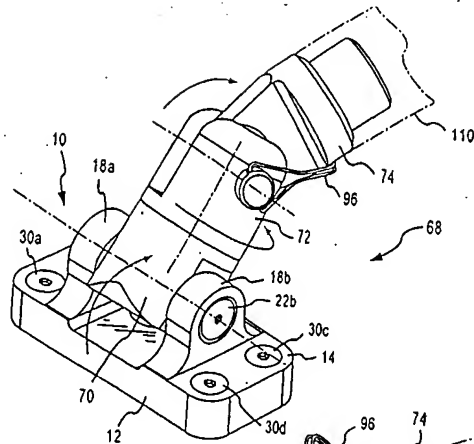


FIG. 8A

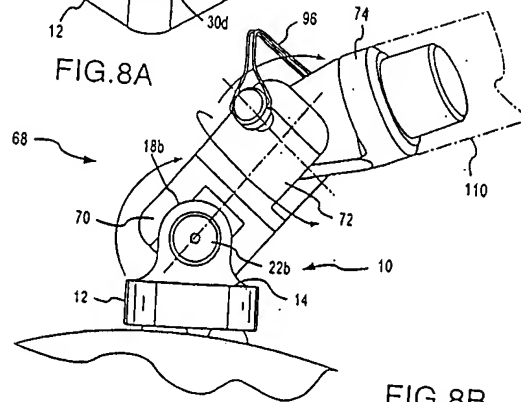


FIG. 8B

Thus, as shown in Figures 5 through 8B, the semi-circular arrows demonstrate that the components of Applicant's coupler are positionable not merely in one plane like the Murray apparatus, but in a wide variety of positions, in a wide range of varying planes, along an array of combinations and permutations of x-, y-, and z-axes.

For Example, Figure 6, however, begins to demonstrate the mechanical departure of the coupler from the Murray apparatus. The semi-circular arrow shown on plug 72 of coupler 10 shows yet another of the variable positions of the coupler by showing that because of the unique use of plug 72 in combination and mechanical cooperation with neck 74 and tub 70, components of coupler 10 may also and simultaneously rotate around a y-axis. Figure 7 shows that a segmented portion of coupler 10, namely neck 74, may rotate around yet another z-axis. As indicated in the "Brief Description of the Drawing," Figure 8A shows that tub 70 may rotate around the axis formed by first threaded bolts 22a,b in opposing yokes 18a,b, while at the same time plug 72 may rotate in relationship to tub 70, while at the same time neck 74 may be variably positioned in yet another plane or direction -- all of which is shown again for emphasis from an alternative perspective in Figure 8B, which also demonstrates graphically that the flat bottomed base 12 is securely fastenable to a curved surface through the use of the ball washer assemblies 40.

Thus it is clear that for at least these reasons the Murray Patent fails to fairly meet the all-elements rule, and for that reason alone independent claim 1 should be allowed.

B. Structural Disagreements Marked-up Figures 4 and 5 from the Murray Patent are reproduced from the Examiner's office action in this document for an additional reason.

Beginning on page 8 of the Reopened Office Action the Examiner includes a number of comments about the arguments advanced by Applicant in Appellant's Amended Appeal Brief. For example, the Examiner states that Applicant "does not fully appreciate that figures 4 and 5 show separate sections of the assembly of figure 1." The term "figure 1" apparently refers to Figure 1 of the Murray Patent. The Examiner goes on to state: "Figures 1, 4 and 5, as depicted together above, show that element 100, while similar in structure to element 55, is in addition to and assembled away from element 55." (Emphasis added.) Applicant respectfully disagrees.

On further reflection, the Examiner will appreciate that element 100 and element 55 are identical, not similar, in structure; that the differences in structure occur in connection with the

configuration of the substrate on which component 100 and component 55 are mounted. Thus, component 100 is mounted on base 49 having a flat planar surface (see Reopened Office Action, page 4), whereas component 55 is mounted on a tube formed with T-fitting slides 71. Again, the structural difference resides in the different substrates, not in component 100 and component 55. What is more germane, however, is the fact that under no interpretation of the components of the Murray apparatus can either Figure 4 or Figure 5 be construed to show the tub and plug of Applicant's apparatus, an argument made clear in subparagraph C. below.

In addition, it is evident that the Examiner's efforts to identify in the Murray apparatus the elements of Applicant's coupler are incorrect in fact, and incorrect mechanically.

Thus, on page 4 of the Reopened Office Action, immediately beneath marked-up Figures 4 and 5, the Examiner asserts that the Murray Patent shows "a tub...adjustably connectable to the base...[and] a plug...repositionably attachable to the tub...[and] a neck rotatably insertable in the plug..." That assertion fails when that same assertion includes the reference numerals assigned by the Examiner to the components of the Murray apparatus. For example, the Examiner attempts to reconstruct Applicant's coupler by stating that component 100 is a "tub," and that component 42 is a "plug" repositionably attachable to the tub. Component 42 is, however, not reasonably comparable to the variably positionable plug 72 of Applicant's coupler. Indeed, component 42 is described in the Murray Patent as one of the "legs" of the U-shaped structure that supports the canopy: see Murray Patent, column 3, lines 8-11, lines 33-38, lines 55-60, and column 4, lines 1-7. If comparable to any elements of Applicant's coupler, leg 42 would be shaft 110, shown in Applicant's Figure 5 – which is connectable to neck 74, not tub 70.

Accordingly, the elements of Applicant's coupler, and the components of the Murray apparatus, do not cooperate in the same manner.

Accordingly, for at least this structural reason the Murray Patent does not satisfy the all-elements rule of MPEP §2131, and rejections of claims 1-3 therefore should be withdrawn.

C. The Murray Apparatus is Not Mountable on a Curved Surface. On page 4 of the Reopened Office Action the Examiner asserts that the apparatus of the Murray Patent is mountable on a curved surface. Applicant respectfully disagrees, and asserts that such an argument is unreasonable.

1. The marked-up figures included by the Examiner on page 4 confirm that the underside of base 40 is flat. The Examiner concedes that the underside of base 40 is a “flat planar surface.” See Reopened Office Action, page 4. A flat planar surface is not designed for mounting on a curved surface absent additional means for mounting. Nothing in the Murray Patent suggests or teaches that the Murray apparatus is intended to be mountable on a curved surface, and the Examiner points to none. Were the Murray apparatus mounted on a curved surface, it would not be mounted securely, and likely would tear loose from the hull of a craft because none of the other components attached to the Murray apparatus are variably positionable.

2. The Examiner asserts that his extracted marked-up portion of Figure 1 of the Murray Patent shows the Murray apparatus mounted on “a curved surface of the watercrafts as seen in figure 1” (see Reopened Office Action, pages 4 and 8). Applicant disagrees.

Figure 1 of the Murray Patent shows the Murray apparatus mounted on a flat upper surface, or deck, of the watercraft. The Examiner has offered no proof as part of the Examiner’s *prima facie* case that the deck on which the Murray apparatus is mounted is curved. Regardless, the flat planar surface is not designed for mounting on a curved surface.

Accordingly, for at least these structural reasons the Murray Patent does not satisfy the all-elements rule of MPEP §2131, and the rejections of claims 1-3 therefore should be withdrawn.

3. The Examiner asserts, however, a second argument about curved surfaces. The second argument is inconsistent with the assertion that the Murray Patent shows the Murray apparatus mounted on “a curved surface of the watercrafts as seen in figure 1.” The second argument appears on page 5 of the Reopened Office Action. There the Examiner states:

(Note that while the Murray curved surface does not curve at its point of contact with element 40, it does curve elsewhere and is thus a curved surface with the broadest reasonable interpretation of the claim language.) [Emphasis added.]

Applicant has several responses to that argument.

First, as already indicated the Murray apparatus has no curved surface. Accordingly, there is no “Murray curved surface.”

Second, if the Examiner asserts that the body of the watercraft shown in the Murray Patent “curves elsewhere,” as also indicated above there is no evidence of that fact.

Third, to argue that the surface of the watercraft shown simply must curve elsewhere or somewhere fails to recognize that the Murray Patent shows the Murray Apparatus mounted on flat surfaces, and that the Murray Patent makes no comment about its efficacy when mounted on a curved surface.

Fourth, Applicant respectfully disagrees that such an argument either is “reasonable” or is “the broadest reasonable interpretation of the claim language.” See Reopened Office Action, page 3. Claim language must be read in light of the specification. As shown above, the specification emphasizes that one of the unique features of Applicant’s coupler is that it can be mounted on a curved surface. Nothing in the specification of the Murray Patent states that. The Examiner’s argument seems to be this: Although Applicant’s arguments are valid, they are irrelevant because the Examiner may reject claims based on the “broadest reasonable interpretation of claim language.” The corollary to that argument would be that during examination, no regard need be paid to the specification, its definitions, and its explanations. However, the Examiner’s statement of the rule is incomplete: MPEP §2111.01 does not state that pending claims must be given their broadest reasonable interpretation. Rather, that section clearly requires that “...pending claims must be given their broadest reasonable interpretation consistent with the specification.” (Emphasis added.) MPEP §2111 goes on to state that the claims should be considered “...as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description....” (Emphasis added.) Clearly, therefore, claims are not to be examined by giving them their broadest possible interpretation. Rather, pending claims are to be given their broadest reasonable interpretation, the “reasonableness” being with reference to the specification. That is logical. Claims are not drafted in a vacuum, but are shaped, defined, and given meaning by the specification of an application.

D. The Murray Patent Does Not Disclose Either a Plug or a Neck. The Murray Patent also does not satisfy the “all-elements” rule of MPEP §2131 because the Murray Patent does not disclose either a plug or a neck.

An element of Applicant's independent claim 1 is a plug repositionably attachable to the tub. See Listing of Claims, page 4, line 10. The plug is shown in Figure 5 of the Application as plug 72 as reproduced in this document.

The Examiner asserts on page 4 of the Reopened Office Action that the Murray Patent discloses a plug. The plug of the Murray Patent, as proposed by the Examiner, consists of (i) a component 42, (ii) "upper portion of 42," and (iii) a component 71. See Reopened Office Action, page 4, lines 3-2 of the bottom of that page. The Murray Patent, however, assigns reference numeral 42 to one of two legs 42 and 44. See Murray Patent, column 3, lines 55-60. The Examiner's term of "upper portion of 42" would apparently, therefore, refer to the upper portion of leg 42 -- which extends, as shown in Figure 2 of the Murray Patent, all the way up to canopy 22. The "upper portion of [leg]" does not, therefore, as claimed by Applicant, cooperate structurally with a neck rotatably insertable in the plug as claimed by Applicant. Indeed, as shown in the Examiner's marked up version of Figure 5 of the Murray Patent, the Examiner states three lines from the bottom of page 4 that component numbered 100 by the Examiner is a "tub (100)." Yet the Examiner states two lines from the bottom of page 4 that component numbered 55 is purportedly a "neck (55)." As already shown, however, components 100 and 55 are the same components shown from different perspectives and mounted on different substrates. Regardless, the same component cannot be both a tub and a neck, with or without an undefined component described as an "upper portion of [leg] 42". The addition of an undefined component 71, which in fact is called a "T-fitting" in the specification of the Murray Patent does not, Applicant respectfully submits, support the Examiner's structural arguments. See Murray Patent, column 4, line 12.

The Examiner's argument on page 9 of the Reopened Office Action is, therefore, without merit. The Examiner argues that "the fact that the Murray plug is of a two-piece construction is irrelevant since the applicant does not claim one-piece construction." See Reopened Office Action, page 9. As indicated, that argument is unpersuasive. When claiming an element of a claim, no rule of patent law requires that each claim recite that the element is on one-piece construction. In addition, the Figure above shows that the plug is of one-piece construction. Finally, the tub and plug that the Examiner tries to fashion from the Murray apparatus do not cooperate in the same fashion as does the tub and plug of Applicant's apparatus.

Accordingly, contrary to the Examiner's assertion that the Murray Patent discloses a plug and a neck, it does not, and at least for that reason the rejections of claims 1-3 should be withdrawn.

For these reasons, and for the reasons articulated below, Applicant respectfully requests that the rejections of claims 1-3 under 35 U.S.C. §102(b) be withdrawn.

Discussion of Rejections under 35 U.S.C. §102

The fundamental teaching on the doctrine of anticipation was set forth by Judge Rich in *In re William J. King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986):

It is axiomatic that anticipation of a claim under §102 can be found only if the prior art reference discloses every element of the claim.

In re William J. King at 231 USPQ 139 (emphasis added).

Further, as provided in MPEP §2131, for a reference to anticipate a claim, that reference must teach, or identically describe, each and every element or step of the claim in the identical orientation. *Atlas Powder v. E.I. duPont*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); *Jamesbury Corp. v. Litton Industrial Products*, 756 F.2d 1556, 225 USPQ 253 (Fed. Cir. 1985) (emphasis added). "Anticipation" is a restrictive concept, requiring the presence in a single prior art disclosure of each and every element of a claimed invention. Further, as held in *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001, 18 USPQ2d 1896 (Fed. Cir. 1991), "there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." (Emphasis added)

As discussed above, the Murray Patent does not disclose the identical structure and cooperation of structure as described in the Application.

Applicant, therefore, respectfully urges that the Murray Patent does not anticipate claims 1-3 of Applicant's coupler as claimed, and that those rejections be withdrawn.

First Rejection Under 35 U.S.C. § 103(a)

The Examiner rejected dependent claim 4 as obvious, but claim 4 is patentable because, under 35 U.S.C. §103(a), the claim is not obvious over the Murray Patent in view of U.S. Patent No. 5,704,749 issued January 6, 1998 to Landgrebe ("Landgrebe Patent").

35 U.S.C. §103(a) provides:

A patent may not be obtained though the invention is not identically disclosed or described as set for in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Applicant respectfully submits that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

As predicate to overcoming the rejection of dependent claim 4, Applicant adopts and incorporates by reference the arguments made in connection with the rejections under 35 U.S.C. §102 above.

Moreover, as stated in the MPEP §706.02(j), to establish a *prima facie* case of obviousness, three basic criteria must be satisfied: (1) a suggestion or motivation to modify the cited reference or to combine the teachings in the cited references; (2) a reasonable expectation of success; and (3) the cited references must teach or suggest all the claim limitations. The cited reference “must expressly or impliedly suggest the claimed invention....”

As also provided in MPEP §2143.01, the “mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.”

Also, and rather significant in this instance, Applicant’s disclosure should not be used as a blueprint to reconstruct the claimed coupler out of isolated teachings in the prior art. *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir., 1988).

Indeed, in connection with all §103 arguments advanced by the Examiner, Applicant submits that the attempted combinations urged by the Examiner are individually and collectively impermissible hindsight prohibited by both the Board of Patent Appeals and Interferences (“Board”), and the Court of Appeals for the Federal Circuit (“CAFC”). The case of *Ex parte Wessels and Kaido*, Appeal No. 2004-0462, Application No. 09/915, 861, is an example. While

the case is not binding precedent of the Board, the methodology of analysis based on *In re Fritch* is instructive:

[I]t is our opinion that the examiner has used the hindsight benefit of appellant's own disclosure to pick and choose elements or concepts from the distinctly different systems of the applied references, and then selectively combine the chose disparate elements or concepts in an attempt to reconstruct appellant' claimed subject matter. However, as our court of review [CAFC] indicated in *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992), it is impermissible to use the claimed invention as an instruction manual or "template" in attempting to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious. (Emphasis added.)

Claim 4 is a dependent claim. Having overcome the rejections of independent claim 1, dependent claim 4 is allowable for at least the same reasons that support allowability of independent claim 1.

Although the Examiner argues on pages 5-6 of the Reopened Office Action that "it would have been obvious to modify the coupler of Murray to include, (sic.) frustoconical recesses, as taught by Landgrebe, for the purpose of improving fastener alignment during assembly," the Examiner points to no suggestion, no motivation, no teaching recited in either reference to support the argument.

Further, although the Examiner asserts that it would be permissible to modify the coupler by incorporating features of the Landgrebe Patent, Applicant respectfully submits it is improper to modify the coupler utilizing the reference. See MPEP §2143.01, the heading of which states that "The Proposed Modification Cannot change the Principle of Operation of a Reference." To combine the references in the manner sought by the Examiner is an application of impermissible hindsight in the analysis of Applicant's novel coupler, and would require impermissible modification of the principles of operation of Applicant's coupler.

Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 4.

Second Rejection Under 35 U.S.C. § 103(a)

Contrary to the argument of the Examiner on page 6 of the Reopened Office Action, Claim 5 is patentable because under 35 U.S.C. §103(a) the claim is not obvious over the Murray

Patent in view of the Landgrebe Patent, in further view of U.S. Patent No. 1,257, 536 issued to Schroeder on February 26, 1918 (“Schroeder Patent”).

Incorporating by reference all of the foregoing statements recited in this paper, Appellant also submits that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

Claim 5 also is a dependent claim. Having overcome the rejection of independent claim 1, dependent claim 5 is allowable for at least the same reasons that support allowability of independent claim 1.

Although the Examiner argues on page 6 of the Office Action that “it would have been obvious...to adapt the means for mounting, as taught by Schroeder, to be used at each hole of the Murray means for mounting,” once again the Examiner points to no suggestion, no motivation, no teaching recited in either reference to support such an argument.

Additionally, it is evident that the Schroeder Patent is intended to be deployed only in connection with flat surfaces, not curved surfaces. See Schroeder Patent, Figures 1 and 2, and col. 2, ll. 64-80 for an explanation of that inventor’s recommended use of the Schroeder device on first “a horizontal body portion,” and second, on a “vertical portion.” Unlike the variably positionable coupler claimed and disclosed by Applicant, to reverse the Schroeder device from a horizontal to a vertical orientation, bolt 10 must be removed and reinserted “sideways.” See Figures 1 and 2.

In the Reopened Office Action, at page 6, the Examiner seeks to advance a new argument that the Murray Patent includes the kind of suggestion contemplated by MPEP §706 that would support a *prima facie* case of obviousness. The new argument by the Examiner appears to be that the Murray Patent “suggests [in] (col. 2, ll. 61-65) adaptation for use on land vehicles but does not detail such adaptation.” For the Examiner, that deficiency, apparently, is resolved by the Schroeder Patent because it states that “ball washer means for mounting are beneficial for mounting components in a variety of positions found on land vehicles (automobiles).” The Examiner concludes, therefore, that it would have been obvious to “adapt the Murray means for mounting to a land vehicle...by including ball washers to be used at each hole of the Murray

means for mounting, as taught by Schroeder....” Using the terms used by the Examiner, this paper will refer to the foregoing argument of the Examiner as the “Land Vehicle Argument.”

The problem with the inductive conclusion of the Land Vehicle Argument is, of course, that there is no suggestion in the cited references to modify the Murray apparatus as contemplated by the Examiner. In addition, there is no indication of any reasonable expectation of success. Finally, none of the references, as has been shown in the discussion under §102 above, teaches or suggests all the claim limitations of the coupler disclosed in the Application.

The Land Vehicle Argument contravenes MPEP §2143.01 which states that the “mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” (Emphasis added.)

Also, the Land Vehicle Argument seems to be an instance of constructing an argument by using Applicant’s disclosure as a blueprint to reconstruct the claimed coupler out of isolated teachings in the prior art, contrary to *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir., 1988).

Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 5.

Third Rejection Under 35 U.S.C. § 103(a)

Contrary to the arguments of the Examiner beginning on page 7 of the Reopened Office Action, Claims 6-13 and 16-22 are patentable because under 35 U.S.C. §103(a) the claims are not obvious over the Murray Patent in view of the Schroeder Patent.

Incorporating by reference all of the foregoing statements recited in this paper, Applicant also submits that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

Claims 6-10 depend from independent claim 1.

As Applicant already has indicated, having overcome the rejections of independent claim 1 by showing that the primary reference of the Examiner, namely the Murray Patent, does not anticipate Applicant’s coupler, dependent claims 6-10 are allowable for at least the same reasons that support allowability of independent claim 1.

The Examiner rejected independent claim 11 for obviousness. See page 8 of the Reopened Office Action.

In doing so, the Examiner again invokes the Land Vehicle Argument.

Independent claim 11, however, claims a boom-swivel device 68 that is detachably fixable to base 12. The claims dependent from independent claim 11, and the specification of the Application, show that boom-swivel device 68 includes at least one tub 70 (see claim 19), a plug 72 (see claim 20), and a neck 74 (see claim 21). Applicant incorporates by reference all arguments made in this paper in connection with those elements of the coupler, and submits that Applicant has overcome the rejection of the Examiner.

As to the rejection for obviousness the Schroeder Patent, Applicant has already overcome any application of that reference to Applicant's coupler, and further submits for the Examiner's consideration that there is neither a suggestion or motivation recited in either reference to combine elements in the novel manner of Applicant's coupler, nor any teaching of all the claim limitations. Accordingly although the Examiner argues that "it would have been obvious...to adapt the washer assembly, as taught by Schroeder, to be combined with each hole of the Murray means for mounting...", the Examiner points to no suggestion, motivation, or teaching recited in either reference to support the argument.

In addition, Schroeder offers no teaching or suggestion that the Schroeder device is mountable on a curved surface. Attempting to combine the elements of the Murray Patent with the elements of the Schroeder Patent would result in an assembly that certainly would not be stationary on a curved surface, and could rotate only in one plane. Contrary to the Examiner's argument, the Schroeder ball washer assembly is not "beneficial for mounting components in a variety of positions," but rather only on a horizontal or planar position.

Claims 12-13 and 16-22 are dependent from independent claim 11. As Applicant has indicated, having overcome the rejections of independent claim 11 by showing that the primary reference of the Examiner, namely the Murray Patent, does not apply, dependent claims 16-22 are allowable for at least the same reasons that support allowability of independent claim 11.

Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 6-13 and 16-22.

Fourth Rejection Under 35 U.S.C. § 103(a)

Contrary to the arguments of the Examiner beginning on page 9 of the Reopened Office Action, Claims 14-15 are patentable because under 35 U.S.C. §103(a) the claims are not obvious over the Murray Patent in view of the Schroeder Patent, and in further view of the Landgrebe Patent.

Incorporating by reference all of the foregoing statements recited in this paper, Applicant also submits that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

Claims 14-15 depend from independent claim 11.

As Applicant already has indicated, having overcome the rejections of independent claim 11 by showing that the primary reference of the Examiner, namely the Murray Patent, does not apply, dependent claims 14-15 are allowable for at least the same reasons that support allowability of independent claim 11.

Nothing in any of the cited references suggests or teaches the modifications or combinations argued by the Examiner.

Rejection of Dependent Claims

Regarding the rejection of the dependent claims, in view of the foregoing demonstration of the patentability of independent claims 1 and 11, the dependent claims are, of course, also patentable because they are directly or indirectly dependent on independent claims 1 and 11. Regarding rejections of dependent claims under 35 U.S.C. §103, as provided in MPEP §2143.03, if an independent claim is nonobvious under §103 then any claim depending therefrom is also nonobvious. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Discussion of Rejections under 35 U.S.C. §103

For the Examiner to establish a *prima facie* case of obviousness based on a combination of the content of various references, “there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant.” *In re Cregg W. Dance v. Hoek et al.*, (CAFC, 97-1229, October 30, 1998), citing *In re Raynes*, 7 F.3d 1037, 1039, 28 USPQ2d 1630, 1631 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d

1443, 1445 (Fed. Cir. 1992), emphasis added.

“Obviousness cannot be established by hindsight combination to produce the claimed invention.” *In re Creg W. Dance v. Hoek et al.*, (CAFC, 97-1229, October 30, 1998), citing *In re Gorham*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

Contrary to the Examiner’s goal in this case, to modify Appellant’s invention as shown in the Examiner’s “marked up” figures, to modify a prior art reference to render a patent obvious requires that “the prior art suggested the desirability of the modification.” *In Re Fitch*, 23 USPQ2d 1784 (Fed. Cir. 1992). There is nothing in the cited references that suggest the desirability of the proposed modification.

It is also clear that a reference teaches away from an invention when “it suggests that the line of development flowing from the references’s disclosure is unlikely to be productive of the result sought by the applicant.” *In re Gurley*, 27 Fed. 3rd 551, 553, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994). In reading such a reference, explained the court, the Examiner must ask if a person of ordinary skill in the art would have been discouraged from following the path set out in the reference, or “would [have been] led to a direction divergent from the path taken by the applicant.” *In re Gurley*, at 1131. In other words, teaching away is the antithesis of suggesting that a person of ordinary skill in the art proceed in the direction taken by the applicant.

The references cited do not even consider mounting a flat, planar device on a curved surface. The references include no suggestion at all that a person should consider what the Appellant invented.

In view of these ageless references about what is “obvious” under 35 U.S.C. §103(a), Applicant respectfully urges that the claims be allowed. The structure as both disclosed in the Application, and claimed, differs from the structure disclosed in the references. The references cited by the Examiner do not disclose the cooperation of structure of Applicant’s coupler. The references disclose no teaching or suggestion to support the notion that the coupler is obvious in view of the combination of references cited by the Examiner.

There also is no evidence supporting the Examiner’s arguments. Recent decisions of the Court of Appeals, Federal Circuit require more than argument. The Federal Circuit emphasizes that evidence must support the assertion of a suggestion, teaching, or motivation; if there is no evidence of such a suggestion, teaching, or motivation, it is inappropriate to “make the

inventor's disclosure a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" *In re Debiczak*, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

The evidence, in other words, must show a "skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *Ecolochem, Inc. v. Southern California Edison Company*, at page 11, quoting *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). The Court also emphasized the proof standard by confirming that "[A] rejection cannot be predicated on the mere identification...of individual components of claimed inventions. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." *Ecolochem, Inc. v. Southern California Edison Company*, at page 11, quoting *In re Werner Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

Applicant respectfully submits that the Examiner has used the hindsight benefit of Applicant's disclosure to pick and choose elements or concepts from the distinctly different systems of the applied references, and then selectively combine the chose disparate elements or concepts in an attempt to reconstruct appellant' claimed subject matter, contrary to *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). In that case the court held that it is impermissible to use the claimed invention as an instruction manual or "template" in attempting to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious.

Conclusions

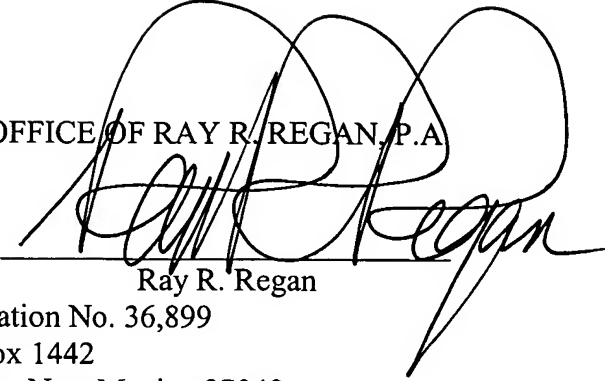
For the reasons set forth above, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1-22.

The remaining references cited by the Examiner, but not relied on for the rejection of claims 1-22, have been noted. Because the remaining references are no more pertinent than the applied references, a detailed discussion of these remaining references is deemed unnecessary for a full and complete Reply to the Office Action.

Respectfully submitted,

LAW OFFICE OF RAY R. REGAN, P.A.

By:


Ray R. Regan

Registration No. 36,899

P.O. Box 1442

Corrales, New Mexico 87048

Telephone (505) 897-7200

Facsimile (505) 897-7201